

REMARKS

Claims 1-3 are pending in this application. Applicant wishes to thank the Examiner for the indication of allowance of claims 1-2. Claim 3 stands rejected under 35 U.S.C. § 103(a). In light of the remarks set forth below, Applicants respectfully submit that all of the pending claims are in immediate condition for allowance.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,157,622 ("Tanaka") in view of U.S. Patent No. 5,088,091 ("Schroeder") in view of U.S. Patent No. 6,697,359 ("George"). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicants.

The Office Action utilizes three references to disclose each of the three limitations recited in Applicants' claim. Applicants respectfully assert that the explicitly recited limitations in claim 3 are not disclosed in the cited reference and that there is no motivation to combine these three references.

The Office Action asserts that the claimed calculation type address having bits (1) corresponding to destinations to which a multicast packet is to be transferred is

disclosed in Tanaka at column 1, lines 60-64, and that it would inherently use bits (1) to indicate the destination. Applicants respectfully disagree.

In Tanaka, a generation section calculates a multicast address according to terminal addresses of each destination terminal stored in the terminal information memory section. There is no disclosure, and it is not inherent, that there is at least one calculation type address having bits (1) corresponding to destinations. As such, this limitation is not disclosed by Tanaka.

The Office Action recognizes that the remaining two limitations in Applicants' claim are not present in Tanaka. The Office Action proceeds to include Schroeder and George to meet the limitations recited in Applicants' claim. The Office Action asserts that it would have been obvious to one skilled in the art at the time of the invention to combine these references because it would "give the routers in the system extra information to use in the routing of packets." See Office Action at 3. However, this motivation to combine fails as a matter of law.

When making an obviousness determination, the prior art must provide a suggestion or motivation to combine the references. Absent this suggestion or motivation, the mere existence of the individual elements at the time of the invention does not render a patented combination of these elements obvious as a matter of law. See, Remcorp Products Co. v. Scottsman Group, Inc., 32 U.S.P.Q.2d 1273, 1279 (N.D. Ill. 1994). While the separate limitations of a claim can appear in various combinations in the prior art, a claim is not obvious if there is no suggestion for combining the references. There must be some suggestion, motivation or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and use them to make the new device. See, Go Lite, Inc. v. Walmart Stores, Inc., 69 U.S.P.Q.2d 1481, 1488 (Fed. Cir. 2004). Here, there is no suggestion or motivation in the prior art to combine all three references.

Here, there is no suggestion or motivation in any of the references to combine all three references. There is no motivation to make the two-fold modification of Tanaka to first modify it in light of Schroeder and then to further modify the combination in view of George. This motivation or suggestion does not exist in the references. As discussed above, merely because each element of a claim is known, it does not render the claim obvious. Here, there is no motivation to combine these three references. As such, Applicants respectfully submit that claim 3 is allowable.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By

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